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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/378,131	12/06/1999	DILLIS V. ALLEN	G-31	8757

7590

12/24/2003

DILLIS V. ALLEN, ESQ.
105 S. ROSELLE ROAD
SUITE 101
SCHAUMBURG, IL 60193

EXAMINER

PASSANITI, SEBASTIANO

ART UNIT PAPER NUMBER

3711

DATE MAILED: 12/24/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/378,131

Applicant(s)

ALLEN, DILLIS V.

Examiner

Sebastiano Passaniti

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

This Office action is responsive to communication received 09/12/2003 (c.m. 09/08/2003) – Amendment A and Change of Address.

This application is a continuation of Reissue application 08/880,748, filed 06/23/1997, now U.S. Patent No. Re.36,950, issued 11/07/2000, which is a continuation of Reissue application 08/369,910, filed 01/09/1995, now abandoned.

Claims 19-28 remain pending.

Following is an action on the MERITS:

Claims 19-28 are rejected as being based upon a defective oath under 35 U.S.C. 251. See 37 CFR 1.175. In view of the changes to the claims presented with the 09/12/2003 amendment and in accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

As per MPEP §1444, it is suggested that the applicant wait until the case is in condition for allowance, and then submit a cumulative supplemental reissue oath/declaration pursuant to 37 CFR 1.175(b)(1).

Applicant is again advised of the practice set forth in MPEP §1451, page 1400-54, and titled, "CONTINUATION REISSUE APPLICATION". An appropriate

Art Unit: 3711

amendment to the continuing data entries must be made in both the instant continuation and the parent reissue application, so that the parent-continuation relationship of the reissue applications is specifically identified and notice is provided of both reissue applications. Here, the applicant is again encouraged to review the manner of making amendments to the specification set forth in MPEP §1453.

Applicant is advised to maintain a clear line of demarcation between the instant claims and the claims of the parent file in order to avoid the need to address the possible existence of double-patenting. Applicant is again directed to MPEP §1451, stating:

"A continuation of a reissue is not ordinarily filed "for distinct and separate parts of the thing patented" as called for in the second paragraph of 35 U.S.C. 251. The decision of *In re Graff*, 111 F.3d 874, 42 USPQ2d 1471 (Fed. Cir. 1997) interprets 35 U.S.C. 251 to permit multiple reissue patents to issue even where the multiple reissue patents are not for "distinct and separate parts of the thing patented." The court stated: Section 251[2] is plainly intended as enabling, not as limiting. Section 251[2] has the effect of assuring that a different burden is not placed on divisional or continuation reissue applications, compared with divisions and continuations of original applications, by codifying the Supreme Court decision which recognized that more than one patent can result from a reissue proceeding. Thus § 251[2] places no greater burden on Mr. Graff's continuation reissue application than upon a continuation of an original application; § 251[2] neither overrides, enlarges, nor limits the statement in § 251[3] that the provisions of Title 5 apply to reissues. 111 F.3d at 877, 42 USPQ2d at 1473. Accordingly, prosecution of a continuation of a reissue application will be permitted (despite the existence of the pending parent reissue application) where the continuation complies with the rules for reissue.

The parent and the continuation reissue applications should be examined together if possible. An appropriate amendment to the continuing data entries must be made to the first sentence of the specification, (see the discussion above under the heading "Divisional Reissue Applications"), and to the bibliographic data sheet reprint (for 09/ and later series) or to the front face of the reissue file wrapper (for 08/ and earlier series), for both the parent and the continuation reissue applications, so that the parent-continuation relationship of the reissue applications is specifically identified and notice is provided of both reissue applications.

Where the parent reissue application issues prior to the examination of the continuation, the claims of the continuation should be carefully reviewed for double patenting over the

Art Unit: 3711

claims of the parent. Where the parent and the continuation reissue applications are examined together, a provisional double patenting rejection should be made in both cases as to any overlapping claims. See MPEP § 804 - § 804.04 as to double patenting rejections. Any terminal disclaimer filed to obviate an obviousness-type double patenting rejection ensures common ownership of the reissue patents throughout the remainder of the unexpired term of the original patent.

If the parent reissue application issues without any cross reference to the continuation, amendment of the parent reissue patent to include a cross-reference to the continuation must be effected at the time of allowance of the continuation application by Certificate of Correction. See the discussion above under the heading "Divisional Reissue Applications" as to how the Certificate of Correction is to be provided.

Claims 19-22 and 24-26 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based. As stated in *Ball Corp. v. United States*, 221 USPQ 289, 295 (Fed. Cir. 1984):

The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application.

Applicant's attention is drawn to MPEP §1412.02, which states that:

Impermissible recapture occurs in a reissue where the claims in the reissue are of the same scope as, or are broader in scope than, claims deliberately canceled in an application to obtain a patent. Where such claims also include some narrowing limitation not present in the claims deliberately canceled in the application, the examiner must determine whether that narrowing limitation has a material aspect to it. If the narrowing limitation has a material aspect to it, then there is no recapture. However, if the narrowing limitation is incidental, mere verbiage, or would be inherent even if not recited (in view of the specification), then the claims should be rejected under 35 U.S.C. §251.

Applicant's attention is also drawn to the decisions *In re Clement*, 131 F.3d 1464, 45USPQ2d 1161 (Fed.Cir. 1997), as well as *Hester Industries, Inc., v. Stein, Inc.*, before the United States Court of appeals for the Federal Circuit, decided May 07, 1998. In this case, and as to claims 19-22 and 24-26, these claims raise the question of recapture of claimed subject matter, since these claims are broader in scope than

Art Unit: 3711

claims amended to secure an allowance in the application for the patent upon which the present reissue is based. While the claims present some narrowing limitations, it has been determined that the narrowing limitations do not have a material aspect to them.

Claims 19-22 and 24-26 are fashioned similar to claim 15 of the original patent (U.S. Pat. No. 5,301,941) to which this reissue pertains. Claims 19-22, 25 and 26, however, lack the recitation of "1.4 inches" in describing the face height, said limitation being included within patented claim 15 to distinguish over the art of record during the prosecution history of the application of the patent. Claim 24 lacks the recitation of "substantially uniform thickness" in describing the body wall, said limitation being included within patented claim 15 to distinguish over the art of record during the prosecution history of the application of the patent.

New claim 23 is an exact duplicate of claim 12 of the original patent. No changes have been made *vis-a-vis* the original patent. As the applicant has canceled original claims 1-18, the intent of the applicant in introducing claim 23 as an exact duplicate of claim 12 is not understood. Original patent claims are never to be renumbered (see 37 CFR 1.173(e)). Clarification is requested. In order to provide a complete examination of the merits of all claims presented in this continuation application, it is noted that claim 23 appears to be allowable over the prior art of record.

New claims 27 and 28 appear to be allowable over the prior art of record.

Applicant's attention is directed to the attached FORM PTO-892, listing all of the prior art documents submitted by the applicant with this continuation reissue application.

Art Unit: 3711

The patent sought to be reissued by this application is involved in litigation. Any further documents and/or materials which would be material to the patentability of this reissue application are required to be made of record in reply to this action. While there is concurrent litigation related to this reissue application, action in this reissue application will NOT be stayed because of applicant's request that the application be examined at this time. Due to the related litigation status of this reissue application, EXTENSIONS OF TIME UNDER THE PROVISIONS OF 37 CFR 1.136(a) WILL NOT BE PERMITTED.


A ONE-MONTH SHORTENED STATUTORY PERIOD FOR RESPONSE HAS BEEN SET IN WHICH TO RESPOND TO THE ABOVE-MENTIONED REMARKS AND REJECTIONS. This one-month period may be extended only upon a showing of *clear justification* pursuant to 37 CFR 1.136(b).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 703-308-1006. The examiner can normally be reached on Mon-Fri (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-305-3579.

Art Unit: 3711

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.


Sebastiano Passaniti
Primary Examiner
Art Unit 3711

S.Passaniti/sp
December 12, 2003